REMARKS

Claims 29-33 and 43-46 were pending in the application. Claims 1-28 and 34-42 are previously cancelled and claims 29, 32, and 43 are amended herein. New claims 47-49 have been added. Support for the amendments and new claims can be found throughout the specification including, but not limited to, paragraphs [0016], [0019], [0020], [0045], and [0047]. No new matter has been presented. Thus, claims 29-33 and 43-49 are under examination.

Claim Rejections – 35 U.S.C. § 102(e)

Claims 29, 32 and 43 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Haffner et al. (US 2004/0167341) ("Haffner"). Applicants respectfully traverse this rejection.

As herein amended, claims 29, 30 and 43 recite:

> 29. A method of inhibiting degradation of a natriuretic peptide present in a subject, comprising:
>
> selecting said subject on the basis of a diagnosis of congestive heart failure, acute coronary syndrome or acute myocardial infarction;
>
> performing an assay to detect a natriuretic peptide in a sample obtained from said subject;
>
> determining a treatment regimen based in part on the presence or amount of said natriuretic peptide; and
>
> administering one or more inhibitors of prolyl-specific dipeptidyl peptidase ("DPP") to said subject in an amount sufficient to inhibit degradation of the natriuretic peptide by prolyl-specific DPP.
>
> 32. A method for increasing the level of natriuretic peptide function in a subject, comprising:
>
> selecting said subject on the basis of a diagnosis of congestive heart failure, acute coronary syndrome or acute myocardial infarction;
>
> performing an assay to detect a natriuretic peptide in a sample obtained from said subject;
>
> determining a treatment regimen based in part on the presence or amount of said natriuretic peptide; and

administering one or more inhibitors of prolyl-specific DPP to said subject in an amount sufficient to inhibit degradation of the natriuretic peptide in said subject by prolyl-specific DPP.

43. A method of treatment, comprising:

selecting said subject on the basis of a diagnosis of congestive heart failure, acute coronary syndrome or acute myocardial infarction;

performing an assay to detect a natriuretic peptide in a sample obtained from said subject;

determining a treatment regimen based in part on the presence or amount of said natriuretic peptide; and

administering one or more inhibitors of prolyl-specific DPP to said subject in an amount sufficient to inhibit degradation of B-type natriuretic peptide in said subject by prolyl-specific DPP. (emphasis added)

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Haffner *et al.* patent application is cited for allegedly "teach[ing] a method for treating congestive heart failure by administering to a patient a compound that inhibits a dipeptidyl peptidase, including DPP-IV. See page 3, paragraphs 0027-0028 and 0030." Office Action, page 4. Applicants respectfully submit that, as amended, the Haffner et al. application does not teach or suggest each of the recited claim limitations and, therefore cannot anticipate claims 29, 32, and 43.

As amended, each of claims 29, 32, and 43 recite two steps for "performing an assay to detect a B-type natriuretic peptide in a sample obtained from said subject" and "determining a treatment regimen based in part on the presence or amount of said natriuretic peptide." The Haffner et al. application does not teach either performing an assay to detect a natriuretic peptide or determining a treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject. Indeed, the Haffner et al. reference makes no mention of natriuretic peptides, including B-type natriuretic peptides. Haffner et al. thus cannot anticipate claims 29, 32, or 43.

Because the Haffner et al. application does not teach or suggest each and every element of the instant claims, no prima facie case of anticipation has been established. Therefore, in light of the arguments and amendments presented herein, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claim Rejections – 35 U.S.C. § 103

A. Claims 30 and 44

Claims 30 and 44 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haffner in view of De Meester et al. (Biochemical Pharmacology, vol. 54, pp. 173-179 (1997)) ("De Meester"). Applicants respectfully traverse this rejection.

The U.S. Supreme Court decision in *KSR International v. Teleflex Inc.* (82 U.S.P.Q.2d 1385) modified the standard for establishing a *prima facie* case of obviousness. Under the *KSR* rule, three basic criteria are considered. First, some suggestion or motivation to modify a reference or to combine the teachings of multiple references still has to be shown. Second, the combination has to suggest a reasonable expectation of success. Third, the prior art reference or combination has to teach or suggest all of the recited claim limitations.

Claims 30 and 44 depend from claims 29 and 43 respectively. As such, claims 30 and 44 incorporate all limitations of claims 29 and 43 respectively. As amended, claims 29 and 43 recite two steps for "performing an assay to detect a B-type natriuretic peptide in a sample obtained from said subject" and "determining a treatment regimen based in part on the presence or amount of said natriuretic peptide."

As discussed above, the Haffner et al. reference fails to disclose either performing an assay to detect a natriuretic peptide or determining a treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject. The De Meester et al. reference is cited solely for the disclosure of a DPP inhibitor comprising a phosphonate moiety. As such, De Meester et al. does not cure the deficiencies in the primary Haffner *et al,* application.

Haffner et al. and De Meester et al. – considered alone or in combination – fail to teach or suggest either step of performing an assay to detect a natriuretic peptide or determining a treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject. Indeed, neither reference mentions natriuretic peptides, including B-type natriuretic peptides.

Because the cited references fail to teach or suggest all of the recited claim limitations, Applicants respectfully submit that no *prima facie* case of obviousness has been established. Applicants request that the Examiner withdraw the rejection of claims 30 and 44 under 35 U.S.C. § 103(a).

B. Claims 31 and 45

Claims 31 and 45 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haffner in view of Bergmann et al., (US 6,756,483) ("Bergmann"). Applicants respectfully traverse this rejection.

Claims 31 and 45 depend from claims 29 and 43 respectively. As such, claims 31 and 45 incorporate all limitations of claims 29 and 43 respectively. As amended, claims 29 and 43 recite two steps for "performing an assay to detect a B-type natriuretic peptide in a sample obtained from said subject" and "determining a treatment regimen based in part on the presence or amount of said natriuretic peptide."

As discussed above, the Haffner et al. application fails to disclose either performing an assay to detect a natriuretic peptide or determining a treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject. The Bergmann et al. reference is cited solely for the disclosure of a DPP inhibitor comprising an antibody or antibody fragment. As such, Bergmann et al. does not cure the deficiencies in the primary Haffner *et al,* application. Haffner et al. and Bergmann et al. – considered alone or in combination – fail to teach or suggest either step of performing an assay to detect a natriuretic peptide or determining a

treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject.

Because the cited references fail to teach or suggest all of the recited claim limitations, Applicants respectfully submit that no *prima facie* case of obviousness has been established. Applicants request that the Examiner withdraw the rejection of claims 31 and 45 under 35 U.S.C. § 103(a).

C. Claims 33 and 46

Claims 33 and 46 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haffner in view of Mills et al. (Journal of the American College of Cardiology, vol. 34, no. 1, pp.155-162 (1999)) ("Mills"). Applicants respectfully traverse this rejection.

Claims 33 and 46 depend from claims 32 and 43 respectively. As such, claims 33 and 46 incorporate all limitations of claims 32 and 43 respectively. As amended, claims 32 and 43 recite two steps for "performing an assay to detect a B-type natriuretic peptide in a sample obtained from said subject" and "determining a treatment regimen based in part on the presence or amount of said natriuretic peptide."

As discussed above, the Haffner et al. application fails to disclose either performing an assay to detect a natriuretic peptide or determining a treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject. Mills et al. is cited solely for the disclosure that human recombinant B-type natriuretic peptide is used therapeutically in congestive heart failure. As such, Mills et al. does not cure the deficiencies in the primary Haffner *et al,* application. Haffner et al. and Mills et al. – considered alone or in combination – fail to teach or suggest either step of performing an assay to detect a natriuretic peptide or determining a treatment regiment based in part on the presence or amount of a natriuretic peptide in a sample from a subject.

Because the cited references fail to teach or suggest all of the recited claim limitations, Applicants respectfully submit that no *prima facie* case of obviousness has been established. Applicants request that the Examiner withdraw the rejection of claims 33 and 46 under 35 U.S.C. § 103(a).

CONCLUSION

Applicant respectfully submits that all rejections and objections have been obviated and that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the telephone number listed below so that they may be resolved without the need for an additional action.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16 1.17, or credit any overpayment, to Deposit Account No. 23-2415. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 23-2415.

Respectfully submitted,

Date: March 18, 2009

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